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09/633,846	08/07/2000	Dave Frederickson	12368/79201	3409

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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/633,846
Filing Date: August 07, 2000
Appellant(s): FREDERICKSON ET AL.

Mitchell J. Weinstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 12, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 16 and 20-22 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,100,883	Lupinski et al.	07-1978

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 16 and 20-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lupinski et al. (US 4,100,883).

Regarding **claim 16**, Lupinski et al. discloses a corrosion-resistant coated and cured strap comprising an elongated metal strap base element (Fig. 4, #74), the metal strap base element having a width defining first and second sides and a thickness defining a pair of opposing edge regions (Fig, 4, #76A and #76B); and a melted and cured powder coating (Fig. 4, #78) on the base element (Fig. 4, #74), the coating having a first substantially consistent thickness at the first and second sides (Fig. 4, #78) and a second substantially consistent thickness at the edge regions (Fig. 4, #80B and #80A), the first and second thicknesses being different from one another, wherein the coating has a greater thickness at about the pair of opposing edge regions (Fig. 4, #80A and #80B) than on the first and second sides (Fig. 4, #78). However, Lupinski et al. fails to disclose the coating thickness having a greater thickness at about the pair of opposing edge regions and about regions of the first and second sides adjacent the pair of opposing edge regions than on the first and second sides to define a dog-bone profile.

Normally, it is to be expected that a change in shape of the coating thickness would be an unpatentable modification. Under some circumstances, however, changes such as shape may

impart patentability to a product if the particular shape claimed produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to change the shape of the coating thickness in Lupinski et al. to define a dog-bone profile. One skilled in the art would have been motivated to do so in order to form a corrosion-resistant coated and cured metal strap, since it has been held that a change in form or shape of the coating thickness would be an unpatentable modification in absence of showing unexpected results.

Regarding **claim 20**, the first thickness of the coating is about 0.2 thousandths of an inch to about 5.0 thousandths of an inch (see col. 9, lines 1-3 and lines 21-23). Regarding **claim 21**, the first thickness of the coating is about 0.6 thousandths of an inch to about 1.2 thousandths of an inch (see col. 9, lines 40-43). Regarding **claim 22**, the first thickness of the coating is about 0.8 thousandths of an inch (see col. 9, lines 41-43).

(11) Response to Argument

Rejection under 35 U.S.C. 103

Appellants argue that in viewing Fig. 4, along with the text of col. 6, lines 7-23 of Lupinski, and comparing this to Fig. 5 of Lupinski, "it is clear that Lupinski teaches away from a coating profile in which the coating is thicker at the ends than at the center portion. And, although Lupinksi does not show a "traditional" dog-bone profile, it is submitted that the configuration of Fig. 4 is akin to such and that the teaching of Lupinski away from this profile is equally well applicable and analogous to teaching away from the claimed dog-bone profile. It is

Applicant's position that in the present instance, the general rule regarding the inapplicability of a teaching away reference to establish a prima facie case of obviousness applies. That is, in the instant case, because Lupinski teaches away from a dog-bone profile (or anything other than a constant thickness coating), it simply cannot be used to establish a prima facie case of obviousness."

In reference to Fig. 4 of Lupinski, Lupinski clearly teaches a coating profile in which the coating is thicker at the edge regions (80A and 80B) of the metal strap than at the sides of the metal strap (78). Although, Lupinski mentions in col. 6, lines 7-23 that the shape of the coating in Fig 4 is undesirable, it is still being taught as known in the art and therefore does not constitute a teaching away. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Therefore, Lupinski clearly teaches a metal strap with a thicker coating on the edge regions than on the sides and it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the shape of the coating thickness to define a dog-bone profile, since there is no showing that the particular shape claimed produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. One skilled in the art would have been motivated to do so in order to form a corrosion-resistant coated and cured metal strap, since it has been held that a change in form or shape of the coating thickness

would be an unpatentable modification in absence of showing unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Catherine A. Simone
May 11, 2005

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